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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,771	07/31/2000	Mark H. Wyzgala	BSC0114052	5428

26389 7590 04/23/2003

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
3732	16

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/629,771	Applicant(s) Wyzgala et al
Examiner Ralph Lewis	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Amendment B, filed January 07, 2003

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-21 and 23-32 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-21 and 23-32 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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### **Rejections based on Obvious-type Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.2d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6096,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '054 set forth the currently claimed drive shaft ('054 claim 1), expandable .polymeric ablation burr ('054 claims 1, 6) and "expansion control system" ('054 claims 4, 11) as well as the method of use ('054 claims 24, 25). Merely setting forth the claimed '054 in the terms of the present claims would have been obvious to one of ordinary skill in the art.

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In response to the present obvious-type double patenting rejection, a terminal disclaimer was filed signed by "Todd Messal, Patent Attorney." Attorney Messal, however, is not listed on the power of attorney filed with the declaration. A power of attorney to Patent Attorney Messal signed by an owner or a representative of the assignee is required for the submitted terminal disclaimer to be effective.

### **Rejections based on Prior Art**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taheri (4,465,072) optionally in view of Shturman et al (5,897,566).

Taheri discloses a device for removing occlusions within a patient's blood vessel comprising a drive shaft 12 and ablation burr 13 secured to the drive shaft wherein the burr 13 is comprised of a polymeric material in the shape of a tube (balloon) which is expanded from a first to a second larger diameter. The Taheri expandable polymeric burr includes a "plurality of outwardly-extending abrasive burr-like pips or ribs on its outer surface" (column 3, lines 7-10) to scrape or thrombose the walls of the blood vessel. The Taheri abrasive pips or ribs do not

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reasonably meet the “abrasive coating disposed on” limitation, however, one of ordinary skill in the art would have readily appreciated that a conventional abrasive coating could have been applied in place of the abrasive pips disclosed by Taheri as an obvious substitution of conventional abrasives. The substitution is particularly obvious in view of Shturman et al who disclose the use of an abrasive coating on a burr for removing deposits within a patient’s blood vessels. To have used an abrasive coating on the Taheri burr rather than the disclosed abrasive pips would have been obvious to one of ordinary skill in the art in view of the Shuturman et al teaching of the appropriateness for using an abrasive coating on a burr for removing blood vessel deposits.

Applicant argues with respect to the present rejection that “Taheri does not teach or suggest ‘wherein the balloon section is expandable to create a seal with the vessel of stent when in the expanded state’” (remarks page 13). The examiner is of the position that while the functional use of creating a seal with the vessel is not explicitly stated in the Taheri document, it is readily apparent that the Taheri balloon, just like applicant’s balloon is capable of such a use. Thus, all the structural requirements of the present apparatus claims are met by Taheri (as modified by Shturman et al). It is fundamental that a known device does not become patentable even when a new use is discovered for it.

#### **Allowable Subject Matter**

Claims 1-13, 19-21 and 23-32 would be allowed upon the filing of a terminal disclaimer to overcome the obvious-type double patenting rejection above.

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Claims 16 and 18 would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend and upon the filing of a terminal disclaimer to overcome the obvious-type double patenting rejection above.

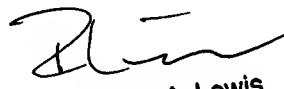
**Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
April 21, 2003

  
Ralph A. Lewis  
Primary Examiner  
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